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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,740	05/11/2001	Kenneth Arneson	20-485	5000

7590 06/16/2008  
MANELLI DENISON & SELTER PLLC  
2000 M Street, N.W., 7th Floor  
Washington, DC 20036-3307

EXAMINER
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LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3688

MAIL DATE	DELIVERY MODE
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06/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/852,740	<b>Applicant(s)</b> ARNESON ET AL.	
	<b>Examiner</b> DANIEL LASTRA	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-28 and 38-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-28 and 38-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1, 2, 5-28 and 38-41 have been examined. Application 09/852,740 (System and method for providing wireless services) has a filing date 05/11/2001 and Claims Priority from Provisional Application 60203885 (05/12/2000).

### **Response to Amendment**

2. In response to Final Rejection filed 12/27/2007, the Applicant filed an RCE on 03/19/2008, which amended claims 1, 9, 14, 18, 21 and 38.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Claims 1, 2, 5-28 are directed to non-statutory because the process must be tied to a particular apparatus, by identifying the apparatus that accomplishes the method steps. For example, said claims recite "creating a wireless service account" but does not identify the apparatus that accomplishes said method step.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (US 6,980,670) in view of Wired (Dialog file 20:09139697)

As per claim 9, Hoffman teaches:

A method of providing e-commerce incentives, comprising:

offering said wireless airtime units to said user in response to said user having actively interacted with a given web site (see column 4, lines 3-25; column 5, lines 15-20; col 17, lines 45-60; col 28, lines 45-65; col 32, lines 15-30).

Hoffman fails to teach that create a wireless service account in response to a user having actively interacted with a website *of a seller of goods or services, said seller of goods or services securing wireless airtime units from a wireless service provider*. However, Wired teaches that it is old and well known in the promotion art to allow users to subscribe and purchase wireless phones and services plans (i.e. wireless account) by interacting with a website of a seller of goods or services, where said seller assists said user with subscribing to wireless plans and therefore, creating or securing a wireless account with a wireless service provider (i.e. "securing wireless airtime units from a wireless service providers") (see Wired paragraphs 16-21). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the application was made, to know that members of the Hoffman's system would access a retail establishment website in order to enroll in wireless service plans (i.e. wireless service account) and therefore, create or secure a wireless account with a wireless service provider, as it is old and well known to subscribe to wireless service plan via the Internet, as taught by Wired.

As per claim 10, Hoffman teaches:

wherein said action on said web site comprises: selection of an electronic advertisement (see column 3, lines 55-67). Purchasing of an item at a website is selecting the item which is also an advertisement.

As per claim 11, Hoffman teaches:

wherein said action on said web site comprises: returning to said web site (see column 4, lines 1-25).

As per claim 12, Hoffman teaches:

wherein said action on said web site comprises: obtaining electronic services (see column 4, lines 1-25).

As per claim 13, Hoffman teaches:

monitoring said web site to determine if said user performs said action on said web site (see column 4, lines 1-25).

5. Claims 1, 2, 5-8, 18, 21-28 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (US 6,424,706) in view of Hoffman (US 6,980,670) and further in view of Wired (Dialog file 20: 09139697).

As per claim 1, Katz teaches:

A method of purchasing goods or services, comprising:

directing payment for goods or services with said wireless airtime units credited to said wireless service account (see column 4, lines 39-67) but fails to teach crediting said wireless airtime units to said wireless service account based on an interaction of said entity with a web site of a seller of goods or services. However, Hoffman teaches

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awarding airtime minutes to users by said users performing action on websites of Internet Reward providers (see Hoffman column 4, lines 3-25; column 5, lines 10-20; col 17, lines 44-60; col 28, lines 45-62; col 32, lines 15-27). Therefore, because users of the Katz system can place orders via online websites (see Katz col 8, lines 15-20), then it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Katz would be motivated to award users with airtime minutes by said users performing actions on said online websites of Internet reward providers, as taught by Hoffman in order that said users have an incentive to visit said website of said Internet reward providers and purchase products or services from said providers.

Katz fails to teach creating a wireless service account in response to a user having actively interacted with a given website of a seller of goods or services, *said sellers of goods or services securing wireless airtime units from a wireless service provider*. However, Wired teaches that it is old and well known in the promotion art to allow users to subscribe and purchase wireless phones and services plans (i.e. wireless account) by interacting with a website of a seller of goods or services, where said seller assists said user with subscribing to wireless plans and therefore, creating or securing a wireless account with a wireless service provider (i.e. "securing wireless airtime units from a wireless service providers") (see Wired paragraphs 16-21). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the application was made, to know that members of the Katz's system would access a retail establishment website in order to enroll in wireless service plans (i.e. wireless service

account) and therefore, create or secure a wireless account with a wireless service provider, as it is old and well known to subscribe to wireless service plan via the Internet, as taught by Wired.

As per claim 2, Katz teaches:

said directing payment is for payment of goods (see column 4, lines 39-67).

As per claim 5, Katz teaches:

said directing payment is for payment of a service (see column 4, lines 39-67).

As per claim 6, Katz teaches:

said directing payment transfers wireless airtime units from a buyer's account to a seller's account (see column 4, lines 39-67).

As per claim 7, Katz teaches:

said wireless airtime units can be used in a metered wireless communications system (see column 4, lines 39-65).

As per claim 8, Katz teaches:

said wireless airtime units can be used in post-paid wireless communications system (see column 8, lines 15-33).

As per claim 18, Katz teaches:

A method of conducting e-commerce, comprising:

crediting a wireless device account associated with said user with a given number of said wireless airtime units (see column 4, lines 39-67) but fails to teach offering said wireless airtime units to said user in exchange for said user actively interacting with a given web page. However, Hoffman teaches awarding airtime minutes

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to users by said users performing action on websites of Internet Reward providers (see Hoffman column 4, lines 3-25; column 5, lines 10-20; col 17, lines 44-60; col 28, lines 45-62; col 32, lines 15-27). Therefore, because users of the Katz system can place orders via online websites (see Katz col 8, lines 15-20), then it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Katz would be motivated to award users with airtime minutes by said users performing actions on said online websites of Internet reward providers, as taught by Hoffman in order that said users have an incentive to visit said website of said Internet reward providers and purchase products or services from said providers.

Katz does not teach creating a wireless service account in response to a user having actively interacted with a given website *of a seller of goods or services, said seller of goods or services securing wireless airtime units from a wireless service provider*. However, Wired teaches that it is old and well known in the promotion art to allow users to subscribe and purchase wireless phones and services plans (i.e. wireless account) by interacting with a website of a seller of goods or services, where said seller assists said user with subscribing to wireless plans and therefore, creating or securing an wireless account with a wireless service provider (i.e. "securing wireless airtime units from a wireless service providers") (see Wired paragraphs 16-21). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the application was made, to know that members of the Katz's system would access a retail establishment website in order to enroll in wireless service plans (i.e. wireless service account) and therefore, create or secure a wireless account with a wireless service



provider, as it is old and well known to subscribe to wireless service plan via the Internet, as taught by Wired.

As per claim 21, Katz teaches:

A method of paying for an offering, comprising:

maintaining a count of said wireless airtime units in said wireless service account associated with an entity (see column 4, lines 39-67); and

reducing said maintained count of wireless airtime units in said wireless service account when said entity exchanges said wireless airtime units for a given good or service (see column 4, lines 39-67). Katz fails to teach crediting said wireless airtime units to a wireless service account based on an interaction of said entity with a web site of a seller of goods or services. However, Hoffman teaches awarding airtime minutes to users by said users performing action on websites of Internet Reward providers (see Hoffman column 4, lines 3-25; column 5, lines 10-20; col 17, lines 44-60; col 28, lines 45-62; col 32, lines 15-27). Therefore, because users of the Katz system can place orders via online websites (see Katz col 8, lines 15-20), then it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Katz would be motivated to award users with airtime minutes by said users performing actions on said online websites of Internet reward providers, as taught by Hoffman in order that said users have an incentive to visit said website of said Internet reward providers and purchase products or services from said providers.

Katz fails to teach creating a wireless service account in response to an entity having actively interacted with a given website of a seller of goods or services, *said*

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*seller of goods or services securing wireless airtime units from a wireless service provider.* However, Wired teaches that it is old and well known in the promotion art to allow users to subscribe and purchase wireless phones and services plans (i.e. wireless account) by interacting with a website of a seller of goods or services, where said seller assists said user with subscribing to wireless plans and therefore, creating or securing a wireless account with a wireless service provider (i.e. “securing wireless airtime units from a wireless service providers”) (see Wired paragraphs 16-21). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the application was made, to know that members of the Katz’s system would access a retail establishment website in order to enroll in wireless service plans (i.e. wireless service account) and therefore, create or secure a wireless account with a wireless service provider, as it is old and well known to subscribe to wireless service plan via the Internet, as taught by Wired.

As per claim 22, Katz teaches:

selling a product wherein said product can be purchased in exchange for a predefined number of said wireless airtime units in a wireless service account associated with a purchaser of said product selling said product through a web site (see column 4, lines 39-67; column 8, lines 15-19).

As per claim 23, Katz teaches:

accepting a predefined number of said wireless airtime units in exchange for said offering (see column 4, lines 39-67).

As per claim 24, Katz teaches:

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by performing an action on a web site (see Katz col 8, lines 15-20) but fails to teach said wireless airtime units are earned by said action. However, Hoffman teaches awarding airtime minutes to users by said users performing action on websites of Internet Reward providers (see Hoffman column 4, lines 3-25; column 5, lines 10-20; col 17, lines 44-60; col 28, lines 45-62; col 32, lines 15-27). Therefore, because users of the Katz system can place orders via online websites (see Katz col 8, lines 15-20), then it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Katz would be motivated to award users with airtime minutes by said users performing actions on said online websites of Internet reward providers, as taught by Hoffman in order that said users have an incentive to visit said website of said Internet reward providers and purchase products or services from said providers.

As per claim 25, Katz fails to teach:

said wireless airtime units are earned by visiting a web site. However, the same argument made in claim 24 regarding said missing limitation is also made in claim 25.

As per claim 26, Katz teaches:

said wireless airtime units represent metered wireless services (see column 5, lines 40-50).

As per claim 27, Katz fails to teach:

crediting at least one wireless airtime unit to said wireless service account in response to behavior by said entity. However, the same rejection applied to claim 24 regarding this missing limitation is also made in claim 27.

As per claim 28, Katz fails to teach:

crediting one or more wireless airtime units to said wireless service account in response to said entity visiting a web site. However, the same argument made in claim 24 with respect to said missing limitation is also made in claim 28.

As per claim 38, Katz teaches:

An incentive offering system, comprising:

a wireless service account associated with an entity, said wireless service account maintaining a count of wireless airtime units (see column 4, lines 39-65) but fails to teach and a processor in communication with both an e-tailer website and said wireless service account, said processor being configured to increase said count of wireless airtime units when said entity actively interacts with a given feature of e-tailer web site. However, Hoffman teaches awarding airtime minutes to users by said users performing action on websites of Internet Reward providers (see Hoffman column 4, lines 3-25; column 5, lines 10-20; col 17, lines 44-60; col 28, lines 45-62; col 32, lines 15-27). Therefore, because users of the Katz system can place orders via online websites (see Katz col 8, lines 15-20), then it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Katz would be motivated to award users with airtime minutes by said users performing actions on said online websites of Internet reward providers, as taught by Hoffman in order that said users have an incentive to visit said website of said Internet reward providers and purchase products or services from said providers.

Katz fails to teach to create said wireless service account in response to said entity having actively interacted with said e-tailer web site *Wherein said e-tailer secures said wireless airtime units from a service provider*. However, Wired teaches that it is old and well known in the promotion art to allow users to subscribe and purchase wireless phones and services plans (i.e. wireless account) by interacting with a website of a seller of goods or services, where said seller assists said user with subscribing to wireless plans and therefore, creating or securing a wireless account with a wireless service provider (i.e. "securing wireless airtime units from a wireless service providers") (see Wired paragraphs 16-21). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the application was made, to know that members of the Katz's system would access a retail establishment website in order to enroll in wireless service plans (i.e. wireless service account) and therefore, create or secure a wireless account with a wireless service provider, as it is old and well known to subscribe to wireless service plan via the Internet, as taught by Wired.

As per claim 39, Katz fails to teach:

said e-tailer's web site is configured to monitor activity of said entity to determine if said entity has earned offered wireless airtime units; and said e-tailer's web site is configured to communicate with said processor to update said wireless service account with said earned wireless airtime units. However, the same argument made in claim 38 regarding said missing limitation is also made in claim 39.

As per claim 40, Katz teaches:

said wireless service account is updateable with additionally purchased wireless airtime units (see column 2, lines 1-40) but fails to teach from said e-tailer. However, the argument made in claim 38 regarding said missing limitation is also made in claim 40.

As per claim 41, Katz teaches:

said wireless service account is updateable with additionally purchased wireless airtime units from said wireless service account (see column 2, lines 3-42).

6. Claims 14-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (US 6,980,670) in view of Katz (US 6,424,706) and further in view of Wired (Dialog file 20: 09139697).

As per claim 14, Hoffman does not expressly teach:

creating a wireless service account for said user in response to said user performing said action on said web site. However, Katz teaches providing customer with wireless service accounts (see Katz col 6, lines 40-55). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hoffman would credit unit-minutes to Katz's recipient accounts in order that said recipient would be able to access to said wireless account to purchase goods or services using said unit-minutes.

As per claim 15, Hoffman does not expressly teach:

crediting said wireless service account with said wireless airtime units. However, Katz teaches providing customer with wireless service accounts (see Katz col 6, lines 40-55). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hoffman would credit unit-minutes to

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Katz's recipient accounts in order that said recipient would be able to access to said wireless account to purchase goods or services using said unit-minutes.

As per claim 16, Hoffman does not expressly teach:

crediting said wireless service account when said user purchases wireless airtime units. However, Katz teaches a prepaid card wireless system that allows subscribers to purchase additional wireless minutes (see Katz column 2, lines 15-25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Hoffman would allow a user to purchase additional wireless minutes, as taught by Katz in order that said user is allowed to continue using a communication device when the user's airtime minutes are already used up.

As per claim 17, Hoffman does not expressly teach:

reducing a count of wireless airtime units in said wireless service account when said user uses a wireless communications device based on said wireless service account. However, the same rejection applied to claim 16 is also applied to claim 17.

As per claim 19, Hoffman does not expressly teach:

creating a phone service account for said user in response to said user accessing said electronic information. However, the same argument made in claim 14 regarding this missing limitation is also made in claim 19.

As per claim 20, Hoffman does not expressly teach:

said wireless account is a metered phone service account. However, the same argument made in claim 14 regarding this missing limitation is also made in claim 20.

### **Response to Arguments**

7. Applicant's arguments filed 03/19/2008 have been fully considered but they are not persuasive. The Applicant argues that the prior arts do not teach the limitation "the seller of goods or services securing wireless airtime units from a service provider" because according to the Applicant, the prior arts do not teach the ability of seller to assist a user with creating an account for wireless airtime units and to use wireless airtime units as an enticement for shopping with the seller". The Examiner answers that the claimed limitation "the seller of goods or services securing wireless airtime units from a service provider" is interpreted in light of the Applicant's specification (see Applicant's specification page 12, lines 4-8), as simply that the seller of goods or service create or secure a user's wireless account by offering said user wireless services. Wired teaches that it is old and well known in the promotion art to allow users to subscribe and purchase wireless phones and services plans (i.e. wireless account) by interacting with a website of a seller of goods or services, where said seller assists said user with subscribing to wireless plans and therefore, creating or securing a wireless account with a wireless service provider (i.e. "securing wireless airtime units from a wireless service providers") (see Wired paragraphs 16-21). Therefore, contrary to Applicant's argument, Wired teaches Applicant's claimed limitation.

### **Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/DANIEL LASTRA/  
Art Unit 3688  
June 5, 2008**